

**REMARKS**

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

**The Specification Amendments**

Minor amendments have been made to the specification to supply a missing serial number which was not available at the time of filing and to correct minor typographical errors.

**Regarding the Rejections under 35 U.S.C. §102****Claims 19, 21, 22 and 24**

These claims have been cancelled.

**Claims 25 and 30**

These claims have been amended by incorporating limitations of existing claims. Accordingly, the rejection of these claims is more properly addressed below.

**Regarding the Rejections under 35 U.S.C. §103****Claims 1-7, and 14-18**

Regarding claims 1-7 and 14-18, Applicants respectfully request reconsideration. The Office Action asserts that "Morrison discloses a television program guide system (Fig. 1) wherein upon detection of user input (column 13, lines 48-52) the system will evaluate the current cursor position and determine the desired function (column 13, lines 48-57) for the typical benefit of providing an accurate, user friendly means for identifying the specific function desired by a user from a plurality of available functions (column 13, lines 40-52)." While this statement is somewhat accurate, claims 1-7 and 14-18 require more. It would be more accurate to describe Morrison's teachings as detecting the current cursor position, determining a desired function associated with that position and carrying out that function when a selection device is activated (e.g., a mouse button). However, Morrison appears to be silent on what happens if the user takes an action that is not actuation of the selection device or is otherwise "unmatched to the

Serial No.: 09/815,852

current cursor location". Morrison apparently fails to recognize this possibility and how to address it.

Consider one example given in the specification of the present application at page 16 which states:

"... However, consider the situation where numerical data is entered from a keyboard or remote control 36 but the current cursor location (focus) on the current web page is not at a location that permits text entry. In this event, the input is rejected and the event manager 510, alerted to such rejection, determines that the command should properly be directed to the TV manager 520. The event manager 510 thus forwards the input to the TV manager 520 for action. In this manner, TV control inputs can be differentiated from normal interaction with browser 182. ... "

In this example embodiment, the TV manager 520 might interpret entries of numbers as direct entry of a channel number (not just invalid entries) and shift the display to the selected channel. Thus, the user is freed of having to shift from a TV mode to a Browser mode.

Note that claims 1 and 14 call for "determining that the input signal is unmatched to the current cursor location; and redirecting the input signal to a television manager." While Morrison might teach taking an appropriate action when the input signal is matched to the cursor location, it is submitted that there is no teaching or suggestion for what to do when the input signal is unmatched. There is not even the suggestion of that possibility.

MPEP 2143.03 requires that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). "

Serial No.: 09/815,852

Applicants further note that neither Morrison nor Legall nor any of the other cited art even makes note of any consequences of a mismatched cursor position and entry of a command (Legall's shortcomings are discussed further below). The possibility of unmatched commands is simply is not considered. However, by considering such a scenario, the operation is simplified and navigation between TV and Web functions is enhanced. In view of the failure of the cited Morrison reference to fairly teach or suggest what happens in the event the input signal is mismatched, it is submitted that *prima facie* obviousness has not been established. Reconsideration of claims 1-7 and 14-18 is respectfully requested.

#### Claims 8-13

Regarding claims 8-13, the undersigned notes that the Examiner has asserted that certain of the limitations associated with the event manager are "inherent" to Legall. Applicant wishes to note for the record that MPEP 2112 calls out the requirements for a disclosure to be inherent. In part the MPEP at 2112 states "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ... "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) ..." (Emphasis Added)

Applicant submits that the citation of col. 3, lines 60-67 and col. 4, lines 60-65 of Legall is inadequate to establish inherency, since the "necessarily present" standard is not met. The disclosure of Legall only indicates (in passing) that channels can be selected by entry of a station number ID. Legall simply mentions possible ways to select a channel in passing without further specifying enough detail as to provide one of ordinary skill with any certainty about other conditions which might be imposed for selection of the channel, and further provides no enablement as to any test carried out on a cursor location as required by the claims at issue (as

Serial No.: 09/815,852

-15-

amended). In dispute of the assertion of inherency, Applicants submit that numerous other possibilities exist than the inherency asserted.

Consider by way of example, entry of a station ID might only work if the user follows the entry with an enter command. Such command might be used by the receiver to ascertain that a channel has been selected. Such command might also only function if the user specifies an EPG function, where such an entry might logically be valid. Also, special commands might be segregated on the remote control to distinguish Web commands from TV commands. There is simply not enough information in Legall to establish with certainty the inherency asserted in the Office Action. Further, it is noted that Legall indicates that "the system responds by tuning to the program selected (the program being one of the programs that meets the search criteria)." Thus, such entry of a station ID might only be functional for valid search results (suggesting that such entry might only valid subsequent to a search). There simply is not enough information in Legall for a proper case of inherency to be established since inherency "may not be established by probabilities or possibilities." Certainty is required, and it simply is not present.

That notwithstanding, Applicants have amended claim 8 to incorporate the features of claim 10. Claim 10 has been cancelled. Claim 8, as amended, now requires that "the current web page has a cursor location, and wherein the event manager determines that the input signal is not directed to the current web page if the input signal is not matched to the current cursor location". In view of this amendment, the rejection based upon anticipation by Legall is moot. The rejection posed for claim 10, however, should appropriately be addressed. In this case, the arguments are similar to those presented above for claims 1-7. To summarize, Morrison appears to be silent on what happens in an input signal is not matched to the current cursor location and Legall's disclosure is inadequate as explained above. Accordingly, for the reasons cited above, there can be no *prima facie* obviousness. Reconsideration of claims 8, 9 and 11-13 is respectfully requested.

#### Claims 25-30

Claims 26 and 27 have been cancelled and their features incorporated into claim 25. Claim 25 is therefore believed to be patentable for the same rationale as that indicated for claim 1 in view of Legall's and Morrison's failure to teach that which is asserted in the Office Action.

Serial No.: 09/815,852

In view of this amendment, claims 25 and 28-30 are accordingly believed patentable, and reconsideration is requested.

#### **New Claims 31-46**

New claims 31-46 have been added to more fully characterize certain embodiments consistent with the present invention. Each of the new claims call for, to paraphrase without intent of imposing additional limitations, a cursor location on a web page to be used to determine whether a user command is a television command or a web page command. These new claims clearly involve no new matter and are believed clearly patentable for the reasons explained above in connection with the arguments favoring patentability of the existing and amended claims. Consideration of these new claims is respectfully requested.

#### **Concluding Remarks**

The undersigned additionally notes that many other distinctions exist between the cited references and the invention as claimed. However, in view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position. No amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date.

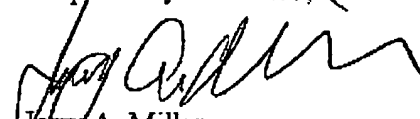
#### **Interview Request**

The undersigned respectfully requests the courtesy of an interview in order to facilitate understanding between the undersigned and the Examiner, thus expediting the conclusion of prosecution. The undersigned can be reached at the telephone number below to arrange such interview.

Serial No.: 09/815,852

-17-

Respectfully submitted,



Jerry A. Miller  
Registration No. 30,779

Dated: 6/7/2005

Please Send Correspondence to:  
Jerry A. Miller  
Miller Patent Services  
2500 Dockery Lane  
Raleigh, NC 27606  
Phone: (919) 816-9981  
Fax: (919) 816-9982  
**Customer Number 24337**

Serial No.: 09/815,852

-18-